

Response to Communication

Applicant: Mark Shu et al.

Serial No.: 10/792,186

Filed: March 3, 2004

Docket No.: M190,148.101 / P0011480.00

Title: SUTURE LOCKING ASSEMBLY AND METHOD OF USE

REMARKS

This is responsive to the Communication mailed April 16, 2009. In that Communication, Applicant's previously-filed Amendment and Response (filed January 16, 2009) was deemed not fully responsive and it was opined that new language referred to non-elected figures. Applicant respectfully disagrees, and requests that the previously-filed Amendment and Response be entered and considered.

In the April 16, 2009 Communication, the Examiner contends that "the Applicant's representative made a restriction/election requirement filed 07/11/08 and elected Group I, Species V, referring to Figs. 24a-24b." This is incorrect. The Election filed July 11, 2008 ("2008 Election") was in response to the Restriction Requirement mailed June 11, 2008 ("2008 Restriction"). The 2008 Restriction did not include or recite any species election requirement. Thus, the 2008 Election did not include any species election. Instead, the 2008 Election simply elected Group 1 (claims 1-31 and 54-58). Thus, the April 16, 2009 Communication's reference to the election requirement filed 07/11/08 as implicating a species election is in error.

While the 2008 Restriction did not include a species election requirement, a previously-issued requirement, mailed February 12, 2007 ("2007 Requirement"), included both a restriction requirement and a species election requirement. It is assumed, therefore, that the current Communication intended to reference Applicant's Response to the 2007 Requirement. With this in mind, the 2007 Requirement specified a restriction requirement between Group I (claims 1-31 and 51-53) and Group II (claims 32-50). In addition, the 2007 Requirement set forth a species election requirement directed only toward the Examiner-identified species of: Species I (FIG. 8); Species II (FIG. 9); Species III (FIG. 15); Species IV (FIG. 16); Species V (FIGS. 24a-24b); and Species VI (FIGS. 25a-25b).

In an Election filed March 16, 2007 ("2007 Election") responsive to the 2007 Restriction, Applicant elected Group I (claims 1-31 and 51-53) and Species V (FIGS. 24a-24b). With this species election, however, Applicant specifically pointed out that none of the Examiner-designated species included FIGS. 32-43b. *2007 Election at pg. 2*. To confirm Applicant's assumptions and elections relative to FIGS. 32-43b, Applicant affirmatively stated it's

Response to Communication

Applicant: Mark Shu et al.

Serial No.: 10/792,186

Filed: March 3, 2004

Docket No.: M190.148.101 / P0011480.00

Title: SUTURE LOCKING ASSEMBLY AND METHOD OF USE

assumption that each of Species I-VI included FIGS. 32-43b. *2007 Election at pg. 2.* To the extent the Examiner intended to assert a different species election (relative to, at least, FIGS. 32-43b), Applicant traversed the un-asserted species election requirement, and requested further clarification.

In the next Office Action (mailed June 4, 2007) issued by the Examiner immediately following submission of the 2007 Election, the Examiner simply noted the election of Group I and the election of Species V. The June 4, 2007 Office Action did not dispute Applicant's assumption that the elected species encompassed or included FIGS. 32-43b. Given this silence, Applicant correctly views that the elected species includes FIGS. 32-43b.

Commensurate with the above-described species election and apart from the Amendment and Response currently at issue, Applicant has submitted claims that were supported by FIGS. 32-43b. For example, in an Amendment and Response filed September 4, 2007, new claims 54-58 were presented. The remarks accompanying these newly-presented claims specified that support for the new claim language was found, for example, at various ones of FIGS. 32-43b. In the immediately following Final Office Action mailed November 16, 2007, the Examiner fully considered claims 54-58. The Examiner did not assert that claims 54-58 were directed toward non-elected figures. Thus, the current Notice is in direct conflict with the Examiner's prior positions.

In summary, the Communication's reference to the election filed July 11, 2008 is in error. Further, at no point did Applicant "non-elect" any of FIGS. 32-43b. Applicant's election of Species V was specifically contingent upon the Examiner's failure to articulate any species election requirement relative to FIGS. 32-43b, and subsequent Actions by the Examiner are consistent with Applicant's assumptions.

For at least the above reasons, then, the Amendment and Response filed January 15, 2009 is fully responsive to the prior Office Action and should be entered. The only "non-elected figures" that Applicant is restricted from claiming are FIGS. 8, 9, 15, 16, and 25a-25b. The Amendment and Response filed January 15, 2009 does not refer to any of these figures for support.

Response to Communication

Applicant: Mark Shu et al.

Serial No.: 10/792,186

Filed: March 3, 2004

Docket No.: M190.148.101 / P0011480.00

Title: SUTURE LOCKING ASSEMBLY AND METHOD OF USE

CONCLUSION

Applicant respectfully submits that pending claims 1-31 and 51-58 are in form for allowance and are not taught or suggested by the cited references. Therefore, entry of the January 16, 2009 Amendment and Response, reconsideration and withdrawal of the rejections, and allowance of claims 1-31 and 51-58 are respectfully requested.

No fees are required under 37 C.F.R. 1.16(b)(c). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 50-0471.

Any inquiry regarding this Response should be directed to Timothy A. Czaja at Telephone No. (612) 573-2004, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

Dicke, Billig & Czaja, PLLC

Attn: MD Matters

Fifth Street Towers, Suite 2250

100 South Fifth Street

Minneapolis, MN 55402

Customer No. 63496

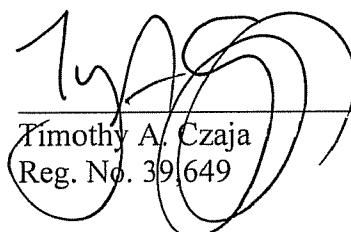
Respectfully submitted,

Mark Shu et al.,

By their attorneys,

Date: May 18, 2009

TAC:jms



Timothy A. Czaja
Reg. No. 39,649